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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/573,647

03/28/2006

Hiroyuki Kikkoji

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08/17/2009

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ALEXANDRIA, VA 22314

EXAMINER

JARRETT, RYAN A

ART UNIT

PAPER NUMBER

2121

NOTIFICATION DATE

DELIVERY MODE

08/17/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 10/573,647	<b>Applicant(s)</b> KIKKOJI ET AL.	
	<b>Examiner</b> RYAN A. JARRETT	<b>Art Unit</b> 2121	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 June 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4,6-15,17 and 18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4,6-15,17 and 18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 04/28/09 has been entered.

### ***Drawings***

It is noted that Applicant agreed to cancel "Fig. 14" in the reply filed on 12/05/08.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 18 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

There is no support in the spec for a “first” and “second” receiver as recited in claim 18, or two different transmitters as recited in claim 18. For example, Fig. 6 only depicts a single communication interface 35f for the integrated service server.

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The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-4, 6-15, 17, and 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "said device attribute information including a..." in lines 6-7. There is insufficient antecedent basis for this limitation in the claim. This limitation should instead be placed after the "control means" limitation, since that is where the "device attribute information" is first introduced.

Independent claims 6-12 and 18 contain similar deficiencies and should also be amended accordingly.

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Claims 1-4, 6, and 7 are directed to means (or step) plus function limitations that invoke 35 U.S.C. 112, sixth paragraph. However, the written description fails to disclose the corresponding structure, material, or acts for the claimed functions.

Applicant is required to:

(a) Amend the claim so that the claim limitation will no longer be a means (or step) plus function limitation under 35 U.S.C. 112, sixth paragraph; or

(b) Amend the written description of the specification such that it expressly recites what structure, material, or acts perform the claimed function without introducing any new matter (35 U.S.C. 132(a)).

If applicant is of the opinion that the written description of the specification already implicitly or inherently discloses the corresponding structure, material, or acts so that one of ordinary skill in the art would recognize what structure, material, or acts perform the claimed function, applicant is required to clarify the record by either:

(a) Amending the written description of the specification such that it expressly recites the corresponding structure, material, or acts for performing the claimed function and clearly links or associates the structure, material, or acts to the claimed function, without introducing any new matter (35 U.S.C. 132(a)); or

(b) Stating on the record what the corresponding structure, material, or acts, which are implicitly or inherently set forth in the written description of the specification, perform the claimed function. For more information, see 37 CFR 1.75(d) and MPEP §§ 608.01(o) and 2181.

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Even if the written description does somewhere disclose the corresponding structure, material, or acts for the claimed functions, it fails to clearly link or associate the disclosed structure, material, or acts to the claimed function such that one of ordinary skill in the art would recognize what structure, material, or acts perform the claimed function.

In this case, Applicant is required to:

(a) Amend the claim so that the claim limitation will no longer be a means (or step) plus function limitation under 35 U.S.C. 112, sixth paragraph; or

(b) Amend the written description of the specification such that it clearly links or associates the corresponding structure, material, or acts to the claimed function without introducing any new matter (35 U.S.C. 132(a)); or

(c) State on the record where the corresponding structure, material, or acts are set forth in the written description of the specification that perform the claimed function. For more information, see 37 CFR 1.75(d) and MPEP 2181 and 608.01(o).

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***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 7-15, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 2003-067289, "A Web Advertisement Delivery System" (hereinafter referred to as JP '289) in view of JP-2003-242018 (hereinafter referred to as JP '018).

For example, JP '289 discloses:

1. An information processing device (e.g., Fig. 1 #21) for receiving service advertisement information, comprising:

transmission means for transmitting user identification information which identifies users, a password, and device identification information which identifies the information processing device to a management device which manages the information processing device (e.g., paragraphs 11, 23), ~~said device attribute information including a memory capacity of a storage device in which said service advertisement is stored;~~

receiving means for receiving registration completion information which indicates that said user identification information, said password and said device identification information were associated with each other and registered at said management device (e.g., paragraphs 11, 23);

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storage means for storing at least said device identification information (e.g., Fig. 1 #21);  
and

control means for controlling said transmission means to transmit ~~device attribute information which indicates the attributes of said information processing device and~~ request information which requests the service advertisement information in the event that said device identification information is not stored in said storage means (e.g., paragraphs 12, 24),

wherein said receiving means receives the service advertisement information ~~corresponding to said device attribute information~~ in response to said request information (e.g., paragraphs 12, 24).

2. The information processing device according to claim 1, wherein said service advertisement information is information that prompts user registration with said management device (e.g., paragraphs 12, 24).

3. The information processing device according to claim 1, wherein said service advertisement information is information that prompts registration for services linked from said management device (e.g., paragraphs 12, 24).

Claims 7-14 and 18 recite limitations similar to those of claims 1-3.

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JP '289 does not explicitly disclose that the control means transmits *device attribute information* to the management device which indicates the attributes of said information processing device, such that the management device is able to transmit the service information *corresponding to the device attribute information*, said device attribute information including a memory capacity of a storage device in which said service advertisement is stored, as called for by claim 1 (and independent claims 7-12 and 18).

Correspondingly, JP '289 also does not disclose:

4. The information processing device according to claim 1, wherein said device attribute information includes performance of a display device on which said service advertisement information is displayed.

15. The information processing device according to claim 12, wherein said device attribute information includes performance of a display device on which said service advertisement information is displayed.

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JP '018 discloses these features in the context of a client/server exchange (e.g., [0003], [0022]-[0026], [0037], [0051]-[0055]). It is noted that JP '018 talks about memory capacity of a client storage device in paragraph 23 for example, where it mentions capacity of cache. Cache is a special memory subsystem.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify JP '289 with JP '018 since all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention. See *KSR v. Teleflex*, 127 S.Ct. 1727 (2007).

One would have been motivated to make such a modification since JP '018 teaches that such a modification provides a comfortable service to a client by preventing a mismatch between a the client's processing performance and the data supplied to said client (e.g., [0004]).

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*Allowable Subject Matter*

Claim 6 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

Claim 17 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:

The prior art of record (in particular Fujii JP '018) fails to teach or fairly suggest “said device attribute information including information indicating the presence of a battery in the information processing device”, as recited in independent claim 6 and dependent claim 17, in combination with the remaining features and elements of the claimed invention.

***Response to Arguments***

Applicant's arguments filed 04/28/09 have been fully considered and are persuasive to the extent that Fujii JP '018 does not teach “said device attribute information including information indicating the presence of a battery in the information processing device”, as recited in independent claim 6 and dependent claim 17. But they are not persuasive to the extent that Applicant argues that Fujii JP '018 fails to teach “said device attribute information including a memory capacity of a storage device in which said service advertisement information is stored” as recited in independent claims 1 and 7-12. It is noted that Fujii JP '018 talks about memory capacity of a client storage device in paragraph 23 for example, where it mentions capacity of cache. Cache is a special memory subsystem. Fujii JP '018 tailors the data sent to the client based at least in part on this cache capacity.

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***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to RYAN A. JARRETT whose telephone number is (571)272-3742. The examiner can normally be reached on 10:00-6:30 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Albert Decady can be reached on (571) 272-3819. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ryan A. Jarrett/  
Primary Examiner, Art Unit 2121

08/10/09